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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,038	07/19/2001	Dorit Wolf	3975.003	8471

7590 08/06/2004

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EXAMINER
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ZHOU, SHUBO

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

9/14

**Advisory Action**

**Application No.**

09/909,038

**Applicant(s)**

WOLF ET AL.

**Examiner**

Shubo (Joe) Zhou

**Art Unit**

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered ~~and an explanation of how the new or amended claims would be rejected is provided below or appended.~~

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 10-17.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*ns*

Applicants are informed that there is an inadvertent error in the Office Action Summary sheet of the Office action mailed 5/3/04 where it was indicated only some of the certified copies of the foreign priority document had been received. It is corrected herein that all the certified copies of the foreign priority document have been received by the Office, as correctly indicated in the Office Action Summary sheet of the Office action mailed 10/3/03.

Continuation of 5.c):

The rejection of claims 10-17 under 35 USC 103 stands because applicants' argument filed 7/9/04 are not persuasive.

Applicants first assert a date of invention at least prior to January 9 2000 based on a publication by Wolf et al., Applied Catalysis A: General 200 (2000) pages 63-77 in an attempt to overcome the rejection. Applicants also state that a declaration under 37 CFR 1.131 would be filed to antedate the reference cited by the Office, Wolf et al. (WO 00/15341, 3/23/2000). However, while the right to rely on the foreign filing extends to overcoming the effects of any intervening references or uses, but there are certain restrictions. For example, the one year bar of 35 USC 102(b) dates from the US filing date, in this case, 7/19/2001, not from the foreign filing date. See MPEP 201.13. Since Wolf et al. (WO 00/15341, 3/23/2000) is a 102(b) type reference, it cannot be antedated by a declaration under 37 CFR 1.131. See also MPEP 715.

Applicants further argue that the reference cited by Wolf et al. does not teach all the limitations of the claimed invention such as steps (iv) and (v). This is not found persuasive because these steps are directed to selecting a catalyst using a numerical random generator and crossing. These are disclosed by Wolf et al. as set forth in the previous Office action. Wolf et al. disclose a method of producing new catalysts. The method comprises providing the catalysts of first generation mixture, restructuring the catalysts using evolutionary principle such as crossing and mutations and through random selections using random generators to produce a second generation of catalysts. See pages 7-9 of the English translation. New generation of catalysts are tested for their performance. The steps are iterated until such time as no further improvement of the catalyst behavior can be ascertained regarding the activity and/or selectivity for the particular reaction under consideration. See page 9 of the English translation. Also see Tables 2 and 3 for the catalysts of the second and third generations. The mixtures are selected using numerical random generators such as GOSDYF, G05DZF and G05CCF of NAG Library. See page 22 of the English translation.



*John S. Brusca 05 July 2004*  
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PRIMARY EXAMINER